

REMARKS

This submission under 37 CFR 1.114 is responsive to the Office Action mailed April 27, 2007. Accordingly, it is accompanied by a request for continued examination (“RCE”) and a petition to extend the time for response by three months, together with the required fees.

Section 101 Rejections

Claim 1 is rejected as being nonstatutory under 35 U.S.C. §101, allegedly because it combines structural elements and method steps. Applicant respectfully traverses the rejection.

The alleged method is contained in the following description in claim 1:

“said openings being configured so that a substance received by said compartments in a liquid state, filling the compartments to respective said fill levels, where said substance is thereafter frozen in said compartments into a solid state, can be emptied out of the container through said openings in the solid state.”

Claim 1 recites that the openings are structurally configured to permit particular functionality. This is routine and perfectly permissible claiming, i.e., claiming structure by what it does rather than what it is. See MPEP 2173.05(g). *Ex parte Lyell* was a different issue. It had claims like the following:

2. An automatic transmission tool in the form of a workstand and method for using same comprising:

a support means,

and [sic] internally splined sleeve . . . ,

a threaded adjustment bolt . . . ,

and further comprising the steps of

1. positioning the output end of an automatic transmission into said upright sleeve,

2. removing the internal components of said automatic transmission from the casing of said transmission,
3. repairing and replacing said internal components back into said casing, and
4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt. (emphasis added).

The language “further comprising the steps of . . .” signals that the steps to follow are positive claim elements. By this language, the claims in *Lyell* expressly require that a method be performed. Since the same claims also purported to be an apparatus, the Board correctly concluded that the claims were ambiguous and therefore failed to meet 35 U.S.C. §112, second paragraph (however, the Board did not conclude that the claims were nonstatutory).

Lyell is inapposite to the claims here. Claim 1 here does not “comprise” any method steps. Nothing in claim 1 indicates that any method steps must be performed. All that is stated in claim 1 is that the openings are configured so that certain performance *could* be realized, certain functionality could be achieved, i.e., the structure would allow it. To infringe claim 1, all that would be required is to provide structure capable of performing as described, which is classic functional claiming for an apparatus.

Claim 1 is modestly amended to make the fact that the disputed language is functional even more clear.

Section 102 Rejections

The Section 102 rejections are based on Donoghue, U.S. Patent No. 3,347,420 (“Donoghue”). Donoghue was first cited in the Office Action mailed November 14, 2007. In the response dated March 6, 2007, Applicant amended claim 1 in response to the rejection, and explained why the amended language was believed to distinguish over the newly cited reference. The present Office

Action was made final without any comment on the merits of either Applicant's amendments or argument.

MPEP 706.07(a) states that, before a final rejection is proper, a clear issue should be developed between the examiner and the applicant, and that an applicant who is seeking to define his or her invention should receive the cooperation of the examiner to that end. The present Office Action fails to meet these important objectives of MPEP 706.07(a).

To ensure that the issue is developed, Applicant requests a telephone interview with the Examiner, and the Examiner is respectfully requested to call the undersigned to schedule such an interview prior to the issuance of the next Office Action.

Section 103 Rejections

These rejections remain the same and the arguments remain the same. While it is not believed to be necessary, Applicant reserves the right to supplement the record with evidence.

Respectfully submitted,



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